

## **REMARKS**

### **ELECTION/RESTRICTION**

As further discussed below, Applicant respectfully submits that Applicant's February 2008 filing and amendment were appropriate for a number of reasons.

By way of background, on September 27, 2007, Applicant participated in an Interview at the Patent Office with Examiner Russell S. Glass. After that interview, Applicant became aware of U.S. Patent No. 6,529,876 issued to Dart et al. (the '876 patent). Based on Applicant's review of the '876 patent, Applicant believed that the most efficient approach for resolving issues raised by the '876 patent would be to cancel Applicant's then-pending claims and suggest an Interference.

Among other things, and perhaps the most important reason that Applicant's February 2008 filing and amendment were appropriate, Applicant's February 2008 filing will conserve scarce resources both of the Patent Office and of Applicant. Among other things, that suggested Interference is likely to determine whether Applicant makes any further efforts to obtain any claims OTHER than those copied '876 claims. In other words, if Applicant does not succeed in an Interference and instead has to face the Dart '876 patent both in prosecution of this application and in the marketplace, Applicant may elect to drop the present application.

Applicant presumes that the Patent Office likewise does not wish to spend its scarce and valuable time and resources prosecuting the claims that had been pending in this application, if in fact Dart '876 stands as potential prior art, whose status needs to be determined by an interference proceeding. Moreover, in view of the Patent Office already having allowed the '876 claims, Applicant presumes that NO further "prosecution" of those claims will be required - the only

determination that remains to be made is whether they should have issued to Dart or to Applicant. As explained in Applicant's previous filings, the record currently indicates that they should have issued to Applicant.

In fact, and with all due respect, it appears that the Patent Office itself might have declared an interference between the two relevant applications (this one and the one from which the Dart '876 patent issued), without Applicant having to discover the '876 patent and make its own suggestion in that regard. Nevertheless, Applicant stands ready to proceed in that interference and obtain a determination that may relieve the Patent Office of any further need to prosecute the present application.

In addition, and independently of the foregoing, in the present Office communication, the Examiner alleges Applicant's amendment filed on February 11, 2008 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP §821.03). Further in that regard, the Examiner alleges Claims 94-103 are directed to an invention that is independent or distinct from the invention originally claimed. Specifically, the Examiner alleges that Claims 94-103 are drawn to a non-elected invention and are not readable on the elected invention because all the original pending claims have been canceled and newly added claims change the scope of the invention to a method for using a computer to facilitate E&M coding by a medical provider of a patient encounter. According to the Examiner, Claims 94-103 are withdrawn from consideration as being directed to a non-elected invention, since applicant allegedly received an action on the merits for the originally presented invention and this invention was constructively elected by original presentation for prosecution on the merits.

In that regard, Applicant respectfully submits that Applicant's new claims submitted on February 11, 2008 (copied Claims 1-10 of U.S. Patent No. 6,529,876 issued to Dart et al., in Applicant's suggested interference) are readable on the elected invention and do not change the scope of the invention, as the Examiner alleges in the instant Office communication. Applicant believes that the cause of confusion over, among other things, Applicant's presently elected invention, is due in part to the assignment of so many (5 in total thus far) PTO examiners to the prosecution of this case.

Among other things, according to Applicant's records, two restriction/election requirements have been issued by the various PTO Examiner(s) during the prosecution of this application. Specifically, a first Restriction/Election Requirement was issued on April 19, 2001 by Examiner Jeanty. Applicant filed a Response to Restriction/Election Requirement on May 18, 2001, in which Applicant provisionally elected invention Group I (Claims 40-64), drawn to an apparatus for gathering information regarding a patient and generating a billing code related to that information.

On March 22, 2004, Examiner Jeanty issued a second Restriction/Election Requirement . Applicant filed a Response to that Restriction/Election Requirement on April 22, 2004, in which Applicant provisionally elected invention Group I, drawn to: (as with the first election) an apparatus for gathering information regarding a patient and generating a billing code to that information (Claims 49-50, 76-77, 81, and 88); a method for gathering a patient's data and subsequently generating a billing code (Claims 51-54, 78, 82, 85, and 89); and a method for an integrated electronic system for conducting a medical interview of a patient and contemporaneously calculating an appropriated government billing code based on that interview (Claims 57, 79, 87, and 90).

In an Office communication dated February 1, 2006, however, PTO Examiner Bleck withdrew that March 22, 2004 Election/Restriction Requirement. Accordingly, Applicant respectfully submits that, as the application currently stands, it appears that the elected invention is drawn to an apparatus for gathering information regarding a patient and generating a billing code related to that information (invention Group I as provisionally elected by Applicant on May 18, 2001).

Further in that regard, Applicant respectfully traverses the Examiner's allegation that new Claims 94-103 are not readable on the elected invention (since allegedly all the original pending claims have been canceled and newly added claims allegedly change the scope of the invention to a method for using a computer to facilitate E&M coding by a medical provider of a patient encounter). Applicant respectfully submits that Applicant's elected "apparatus for gathering information regarding a patient and generating a billing code related to that information" is used "to facilitate E&M coding by a medical provider of a patient encounter". Among other things, "E&M code" in the above method claim language stands for "Evaluation and Management", as set forth on page 21 of Applicant's original specification: "Figures 1a-1h summarize the elements of the medical evaluation as codified by the Health Care Financing Administration (HCFA) and American Medical Association (AMA). This document is titled "Documentation Guidelines for Evaluation and Management Services." Emphasis added.

Accordingly, Applicant respectfully submits that the "billing code" generated by Applicant's apparatus, is the same or equivalent to the "E&M code" produced by the method of using same, and thus the method claim does read on the elected invention. In other words, Applicant's elected apparatus and the method of newly submitted Claims 94-103 are sufficiently related (as product and process of use, etc.), and thus restriction to only one of them is improper.

In the alternative and to the extent that the Examiner believes that the above remarks are not persuasive, Applicant respectfully sets forth below a further response intended to supplement Applicant's Amendment and Response filed February 11, 2008. Although Applicant respectfully submits that this alternative response is sufficient to address any concerns that the Examiner may have regarding the issues discussed above, Applicant remains concerned that this approach will waste scarce resources, time, and effort of both Applicant and the Patent Office.

## **CLAIMS**

In Applicant's previous amendment, Claims 49-74 and 76-90 were canceled and Claims 94-103 were added by Applicant's suggestion for an Interference between Applicant's application and U.S. Patent No. 6,529,876 issued to Dart et al. (the '876 patent). Subject to the foregoing request that the Patent Office reconsider its position and declare that Interference, Applicant contingently elects to reinstate and pursue allowance of those canceled Claims 49-74 and 76-90. Thus, in this contingent portion of the present Response, Applicant has amended Claims 51, 55, 57, 59, and 83, and Claims 94-103 are withdrawn. Accordingly, after entry of this Amendment, Claims 49-74 and 76-90 will be pending.

On September 27, 2007, Applicant participated in an Interview at the Patent Office with Examiner Russell S. Glass. During that interview, the Examiner suggested that certain claims might be allowable if amended in various ways, as discussed further below. Accordingly, Applicant has elected to pursue that approach and has adopted the Examiner's suggestions from that September 27, 2007 Interview, in the amendments to the claims set forth below.

Specifically, the Examiner suggested that Applicant amend Claim 57 to add the limitations of Claim 70. In addition, the Examiner suggested that Applicant "mirror" method

Claims 81, 82, and 83 after amended Claim 57. Further, the preamble of amended Claim 57 should recite “E & M billing code” instead of the limitation “government billing code”.

As discussed in that interview, Applicant has amended Claim 57 to include all the limitations of Claim 70 and its base Claim 68, and to recite “E & M billing code” instead of “government billing code”. In addition, Applicant has amended method Claim 83 to depend from amended Claim 57. Further, Applicant has amended Claims 51, 55, 57, and 59 to comply with the requirements of 35 U.S.C. §112 (to particularly point out and distinctly claim the subject matter which Applicant regards as his invention). Specifically, Applicant has amended Claims 51, 55, and 57 to clarify that the “information being independent of the description of said medical service” is “clinical research, quality assurance, and/or patient care data base information”, and Applicant has amended Claim 59 to clarify that the “data constituting more than just the final billing code” are “specific details about the patient encounter other than raw codes”. Applicant respectfully submits that these amendments do not change the scope of the claims and are supported in Applicant’s original-filed specification (see: e.g., p. 9, l. 2-11; p. 10, l. 20-p.11, l. 2; p. 13, l. 17-p. 14, l. 10; p. 20, l. 7-17). Accordingly, Applicant sets forth below amendments to Claims 51, 57, 57, 59, and 83 to reflect those suggested by the Examiner, and respectfully submits that response is sufficient to address all the pending rejections of the claims. Moreover, Applicant respectfully submits that, as amended, at least Claim 57 is believed to be allowable, notice whereof is respectfully requested of the Examiner.